

RESPONSE

U.S. Appln. No. 10/624,500

During patent examination, each element of a pending claim is given its broadest reasonable interpretation **consistent with the specification**. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Furthermore, to establish a *prima facie* case of obviousness, the prior art references when combined must, *inter alia*, teach or suggest each and every element of the claim. MPEP § 2143 and In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 1-9 are patentable over WO '202 in view of US '405, US '173, or US '098 because WO '202 in view of US '405, US '173, or US '098 does not teach or suggest the claimed base layer "containing substantially no halogen atoms."

Consistent with the specification, including the description at page 7, lines 4-17, the term "containing substantially no halogen atom" means that the material constituting the pressure-sensitive adhesive tape base material includes no substance containing one or more halogen atoms in the molecule.

The primary reference, WO '202, does not expressly disclose that its film substrate contains "substantially no halogen atoms." Instead, WO '202 discloses only that the thermoplastic used in its film substrate should be "low in water-leachable chlorides." Paragraph bridging pages 5 and 6 of WO '202. The teaching in WO '202 to maintain one component (the thermoplastic) of its film substrate low in water-leachable chlorides is not the same as, and does not amount to, a teaching to maintain each component of its film substrate substantially free of halogens.

In fact, WO '202 discloses that "[p]referred film substrates of the invention contain a ***brominated*** flame retardant." (Emphasis added.) Page 7, lines 6-20. Thus, the claimed base material comprising substantially no halogen atoms does not flow from the teachings of WO '202, such that the claimed base material is also not inherently disclosed by WO '202. See, Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990), which states that the mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish an inherent disclosure; there must be provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art).

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Indeed, rather than suggest the claimed base layer "containing substantially no halogen atoms," the teaching in WO '202 to include a brominated flame retardant in its film substrate is a clear teaching away from the claimed invention, which is evidence of nonobviousness. W.L. Gore & Assoc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983). Furthermore, none of the secondary references, US '405, US '173, or US '098, cures the noted deficiency in WO '202. Therefore, the prior art references, when combined, also fail to suggest, as required by §103, each and every element of the claims.

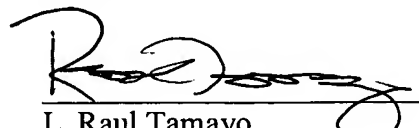
Finally, Applicants have reviewed the examples of WO '202, and WO '202 does not provide any detail whatsoever regarding the structure and composition of its example film substrates.

For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the §103 rejection of Claims 1-9.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
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